DOCKET NO.: MSFT-0103/127334.6
Application No.: 09/482,843
Office Action Dated: October 24, 2006

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS

Status of the Claims

- Claims 121, 124, and 126-135 are pending in the Application.
- Claims 121, 124, and 126-135 stand rejected by the Examiner.
- Claims 121, 127, 128, 130 and 133 are currently amended.

Request for Correction of Inventorship

The current Application, U.S. Application No. 09/482,843, is a continuation of parent Application No. 09/290,363 now U.S. Patent No. 7,103,574. In the current Application, a copy of the signed oath/declaration of the parent application was submitted along with the specification and a preliminary amendment on January 13, 2000.

Applicant respectfully submits that the supplemental oath/declaration filed May 2, 2000 was inadvertently filed without deceptive intent. Applicant respectfully requests withdrawal of the May 2, 2000 supplemental declaration. In its place, Applicant respectfully submits the attached petition for a change of inventorship according to 35 U.S.C. §1.48 (b) and the requisite fee according to 35 U.S.C. §1.17 (i).

The attached petition requests deletion of inventors from the current application, U.S. Application No. 09/482,843, because their invention is no longer being claimed in the current application. The preliminary amendment dated January 13, 2000 cancelled claims 1-105 and added claims 106-135. In conjunction with this preliminary amendment, a correction of inventorship, representing the pending claims, is now respectfully submitted pursuant to 35 U.S.C. §1.48 (b).

The deleted inventors are as follows:

John L. Manferdelli

Ramaranthnam Venkatesan

Paul England

Mariusz H. Jakubowski

Hai Ying Yu

Applicant respectfully believes that the request for withdrawal of the oath/declaration submitted May 2, 2000 along with the submittal of the attached petition for deletion of

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inventorship by reason of amendment fully addresses any concerns regarding the oath/declaration in the current Application. Please contact the below signed Applicant's representative if further action is required.

Claim Rejections Pursuant to 35 U.S.C. §112

Claims 121, 124, and 126-135 stand rejected under 35 U.S.C. §112, first and second paragraph as not disclosing a "data file" and "data structure" and as being indefinite for failing to particularly point out and distinctly claim the subject matter of a "data file" or a "data structure".

Applicant amends Claim 121 to recite a computer-readable medium having stored thereon computer-executable instructions, wherein the instructions, when executed, perform a method to distribute a digital content package from a content server to a computing device within a digital rights management system. The distribution method comprises the steps of receiving, at the content server, a request to distribute the digital content package; and distributing the digital content package in response to receiving the request for the digital content package. Applicant finds support for the amendment on page 14 lines 15-25 and Figures 1 and 3, wherein a requesting distributee (See line 20, page 14) of the digital content data package 12p is a computing device 14. A content server 22 distributes the content data package 12p in response to a request from the computing device 14. The content data package 12p distributed by the content server 22 is described in Figure 3 and pages 15-16.

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Applicant also amends Claims 121, 127, 128, 130 and 133 to remove the terms "data file" and "data structure". Applicant respectfully submits that the amendment to these claims addresses the 35 U.S.C. §112 rejections by eliminating the terms "data file and "data structure" upon which the rejections were based.

Applicant notes that Claims 129, 130, and 133 were amended to properly enumerate the various data fields in a prior Office Action Response. Applicant respectfully requests withdrawal of the 35 U.S.C. §112 rejection of all pending claims.

Claim Rejections Pursuant to 35 U.S.C. §101

Claims 121, 124, and 126-135 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Office action indicates that the claimed invention recites a "data file" and a "data structure" which may not be functional in themselves.

Applicant amends independent Claim 121 to remove reference to a "data file" or a "data structure" and affirmatively claims a computer-readable medium having stored thereon computer-executable instructions, wherein the instructions, when executed, perform a method to distribute a digital content package from a content server to a computing device within a digital rights management system, the distribution method comprising receiving, at the content server, a request to distribute the digital content package; and distributing the digital content package in response to receiving the request for the digital content package. In addition, amended Claim 121 recites various data elements or fields of the digital content package.

Applicant respectfully submits that amended independent Claim 121 recites patentable subject matter for several reasons. In one aspect of amended independent Claim 121, computer-executable instructions, when executed, perform a useful method of distributing a digital content data package to a computer device. The tangible result is the use of computer technology to achieve the distribution of a digital content package having specific data elements. Applicant respectfully submits that amended independent Claim 121 is statutory subject matter under 35 U.S.C. §101 because a computer readable medium is an article of manufacture having a useful purpose of storing instructions that

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when executed by a computer have the tangible result of distributing a digital content package.

Applicant respectfully requests withdrawal of the 35 U.S.C. §101 rejection on amended independent Claim 121 and its dependent Claims 124 and 126-135.

Claim Rejections Pursuant to 35 U.S.C. §103

Claims 121, 124, and 126-135 stand rejected under 35 U.S.C. §103(a) as unpatentable over US. Patent No. 5,765,152 to Erickson. Applicants respectfully traverse the rejection.

The Office Action dated 10/24/2006 on page 12 states that "The Examiner further notes that the only difference between the data file and data structure of the instant claims and the data file and data structure of Erickson lies in non-functionally descriptive material contained within their respective data fields. As such, the content of the non-functionally descriptive material will not distinguish the claimed medium/data file/data structure from the prior art medium/data file/data structure, and accordingly, one of ordinary skill would have recognized that any modification of such non-functionally descriptive material from that already disclosed in the prior art would not have moved to have distinguished the claimed medium/data file/data structure as a non-obvious variant of the prior art medium/data file/data structure. "

Applicant respectfully traverses the rejection. As noted above, Applicant has amended independent Claim 121 to address a computer readable medium that contains executable instructions that perform a method of receiving a request and responding to the request by distributing a digital data package having a specific set of elements. Applicant respectfully submits that Erickson fails to disclose a computer readable medium having computer executable instructions that performs a method of receiving a request and distributing a digital content package having all of the elements recited in amended Claim 121.

Applicant submits that since amended Claims 121 now addresses executable instructions, which are not merely descriptive and have functionality when executed by a computer, then the content and detailed functions of those instructions and the data upon which they work are relevant and not merely non-functional descriptive material.

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Amended independent Claim 121 now recites a computer-readable medium having stored thereon instructions to distribute a digital content package which includes fields representing:

- encrypted digital content to be rendered in accordance with a corresponding digital license, where the encrypted digital content is decrypt-able according to a decryption key (KD) obtained from the license;

- a content or package ID identifying one of the digital content and the package, where the corresponding license also has the content or package ID such that the content or package ID from the package is employed to locate the corresponding license;

- license acquisition information including a location of a license provider for providing the license after identifying the content or package ID to such license provider; and

- a content provider public key, where the corresponding license includes a content provider digital certificate issued and signed by a corresponding content provider private key to show permission from the content provider to provide the corresponding license, such that the content provider public key from the package is employed to validate the content provider digital certificate of the corresponding license.

Thus, upon a user selecting the file with the package, the user can attempt to render the content of the package by way of the license by employing the ID of the package to locate such license in a local store or the like. Alternatively, if the license is not located, the ID can be sent along with a license request to a license provider for the license by directing such license request with the ID to the location set forth in the license acquisition information of the package. Upon receiving the license, the content provider digital certificate therein is validated by way of the content provider public key of the package to ensure that the license provider did in fact have permission to issue the license.

Applicant believes that Erickson sets forth a system where content is packaged in a secure electronic format, and registered on associated registration server, which serves to provide on-line licensing and copyright management for that media. Packages with content are registered on the server and made available for use and possible license through an authorization server. (Abstract)

As best seen in Erickson Fig. 1A, a typical package includes an ID (document ID 22) and the content (in the data container 23). However, it does not appear that the

content is encrypted, as is required by Claim 121, especially inasmuch as the content can be viewed without a license (Abstract) that would have a decryption key for decrypting such encrypted content, as is required by claim 121. Alternatively, if the content is encrypted, the package of the content would have to have the decryption key and not any license, as is required by claim 121, especially inasmuch as the content can again be viewed without such a license.

Considering the content of the digital data package distributed in amended Claim 121, Applicant notes that Erickson does not disclose or even suggest that any license issued for the content of the Erickson package should or could have a content provider digital certificate issued and signed by a corresponding content provider private key to show permission from such a content provider for the any Erickson entity to provide the corresponding license as in amended Claim 121 and would not have such a certificate inasmuch as the Erickson system presumes the license provider and content provider are one and the same. Applicant submits that without such a certificate, it follows that the Erickson content package also does not have a content provider public key that is employed to validate the content provider digital certificate of the corresponding license, as is also required by the contents of the digital data package distributed in amended Claim 121. Accordingly, Erickson does not teach all of the elements of the distributed data package as recited in amended independent Claim 121.

Applicant respectfully submits that Erickson fails to teach or suggest a method wherein a digital data package is distributed by a content server, wherein the digital data package has all of the elements recited in amended independent Claim 121. Accordingly, Applicant respectfully submits that Erickson cannot render obvious independent Claim 121 and its respective dependent claims because all elements of Claim 121 are not found in Erickson. Applicant thus respectfully requests reconsideration and withdrawal of the § 103 rejection of all pending claims because they are patentably distinct over Erickson.

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Conclusion

In view of the above amendments and remarks, Applicant submits that the present application is in a condition for allowance upon entry of the amendments herein. Applicant earnestly solicits a Notice of Allowance for all pending claims.

Respectfully submitted,

Date: Tuesday, December 26, 2006

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